

REMARKS/ARGUMENTS

This amendment is in response to the Office Action mailed on September 10, 2003. Claims 1, 3, 6, 8 and 11 have been amended. Claims 2, 4, 5, 7, 10, and 13-15 have been canceled, without prejudice. Claims 1, 3, 6, 8, 9, 11, 12 and 16 are pending. Reconsideration of the above-identified application in view of the above amendments and the following amendments is respectfully requested.

The disclosure stands objected to because of a grammatical error. The grammatical error noted by the Examiner has been corrected by the above amendment.

Claims 4, 5, 13 and 14 stand rejected under 35 USC §112, first paragraph. These claims have been cancelled without prejudice, thereby rendering this rejection moot.

Claims 1, 8 and 9 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 5,046,611 to Oh in view of U.S. Patent No. 6,098,802 to Asa et al. The Examiner maintains that Oh discloses a tray for holding a plurality of surgical fasteners comprising a base and having a plurality of wells. The Examiner admits that Oh fails to teach or suggest the claimed film and that the wells are isolated from one another in the tray. The Examiner is relying on Asa for the teaching of a tray for sterile pipette tips P, isolated wells 18 and a film 30. The Examiner states that Asa teaches the wells are isolated to prevent cross contamination. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to provide the tray of Oh with the film and isolated wells of Asa to prevent cross-contamination of the fasteners.

Claims 2, 3, 6, and 10-12 stand rejected under 35 USC §103(a) as being unpatentable over Oh in view of Asa as applied to claims 1 and 9 above, and further in view of U.S. Patent No. 4,294,355 to Jewusiak et al. The Examiner maintains that Jewusiak discloses a tray 10 for holding a plurality of surgical fasteners 30. The tray includes a base 11 and two wells defined by channel walls, 14, 15, 16, and 17, and a film 12. The Examiner further maintains that Jewusiak further discloses that the film 12 includes lines of weakness (22, 23) created by scoring or perforating the film. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to provide the tray of Oh-Asa with lines of weakness in the film based on the teachings of Jewusiak to reduce the force required to penetrate the film and access the fastener.

Independent claims 1 and 8 of the present invention have been amended to require that a film be placed over the wells such that accessing one of the surgical fasteners in one of the wells can be achieved while maintaining the sterile environment in the remaining wells, regardless if any of the other wells have been opened. In other words, should the film be penetrated to access one of the surgical fasteners in one of the wells, the sterile environment in the remaining wells is maintained.

Oh discloses a holder for retaining a plurality of hemostatic or ligation clips so that a surgeon may retrieve a clip therefrom during a medical procedure. Thus, Oh was clearly aware of the need for maintaining sterility in his holder, but failed to address these concerns. In addition, just as in the Jewusiak disclosure, Oh's holder is an open channel in fluid communication with all of the clips placed within the holder. Thus, when Oh's tray is accessed to retrieve the first clip, the sterile environment for the remaining clips is no longer maintained. Thus, one of ordinary skill in the art would not have been motivated to modify the construction of Oh's holder because Oh himself was well aware that the holder would be used during medical procedures, yet he made no provisions to account for maintaining each of the clips in a sterile environment before each clip's use. Oh fails to teach or suggest the present invention as exemplified by amended independent claims 1 and 8, which require that the sterile environment in the remaining wells be maintained regardless of whether any of the other wells have been opened.

As stated above, the Examiner is relying on Asa for providing Oh's tray with a film and with isolated wells to prevent cross-contamination of the fasteners. Thus, one of ordinary skill in the art must make two modifications to Oh's tray assembly based on the Examiner's suggestion.

First, the wells must be redesigned so that they are all independent of each other. In Oh's holder, adjacent clip chambers are separated by narrow clip walls 30. The distal end of each clip wall 30 is defined by resilient flap pair 46, 48 on one side of wall 30 and by another resilient flap pair 56, 58 disposed on the opposite side of wall 30. In use, the flap 48 from one wall 30 cooperates with the flap 58 of an adjacent wall 30, as does the flap 46 from the first wall 30 cooperates with the flap 56 of the adjacent wall 30. This construction of Oh is designed to permit the clip 20 to be free to rock about post 34 somewhat, but its motion is limited by contact with opposing flap pairs 46/56 and 48/58. It is clear that this rather complicated well structure would be destroyed if Oh's holder is redesigned so that they are

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all independent of each other, as suggested by the Examiner. Thus, Applicant maintains that one of ordinary skill in the art would not have been motivated to modify Oh's holder as suggested by the Examiner, because to do so would require destroying the basic teachings of Oh's holder.

The second modification that would be required in Oh's holder, would be to add a film to the top surface of Oh's now redesigned holder.

Thereafter, one of ordinary skill in the art would then have to be motivated to further modify the structure of the film that has been added to Oh's holder. More specifically, after adding the film to Oh's holder then one of ordinary skill in the art would have to add lines of weakness in the film to reduce the force required to penetrate the film and access the fastener.

Applicant's maintain that the only motivation for one of ordinary skill in the art to first modify Oh's holder to add a film, and then to further modify the film to add lines of weakness comes from the impermissible use of hindsight reconstruction, which is gained only after reading Applicant's specification. Thus, for this additional reason, Applicant's maintain that the present invention is neither taught nor suggested by the prior art of record.

For the above reasons, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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